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10/822,440	04/12/2004	Wai Ming Choi	072545-0083	1434
21125 7590 05/16/2008 NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604				
EXAMINER				
PIZIALI, ANDREW T				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
05/16/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

doctet@nutter.com

Office Action Summary

Application No.

10/822,440

Applicant(s)

CHOI ET AL.

Examiner

Andrew T. Piziali

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. The amendment and declaration filed on 3/14/2008 have been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not fully enabling because essential matter is not recited in the claims. Applicant's arguments and submitted declaration clearly teach that forming the nonwoven by a wet laid processing technique comprising the addition of an acidic agent followed by the addition of a neutral or alkaline adjusting agent is critical or essential to the practice of the invention, but it is not included in the claims. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-14 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong.

Pierce discloses a nonwoven filter media comprising a layer of glass wool fibers combined with chopped glass fibers (see entire document including page 2, lines 23-25). Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and that the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29). Pierce discloses that the glass wool fibers may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14). Pierce discloses that the chopped glass fibers may have a diameter in the range of 5.0 to 9.0 microns (page 7, lines 22-24). Pierce discloses that the filter media may be a wet laid filter media (page 14, lines 17-18). Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page 10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer.

Pierce discloses that a dispersant may be added to the slurry (page 12, line 1 to page 13, 5) and that the resulting slurry may have a pH of about 2.2 to about 3.2 (page 15, lines 7-17). Pierce does not appear to mention raising the pH of the nonwoven glass layer during the wet laid process after the dispersant is added, but Dong discloses that it is known in the wet laid nonwoven glass art to form a glass fiber nonwoven with uniform weight by first contacting the glass fibers with the combination of a charged viscosity modifier and a dispersant followed by the separate addition of an oppositely charged viscosity modifier, resulting in a slurry with a pH in the range of from about 5 to about 10 (see entire document including column 2, lines 20-43 and column 6, lines 58-64). It would have been obvious to one having ordinary skill in the art at

the time the invention was made to raise the pH from a low pH value, as taught by Dong, because the nonwoven filter media would advantageously possess a uniform weight.

Regarding the claimed gamma value, considering that the nonwoven filter media taught by the applied prior art is substantially identical to the claimed nonwoven filter media in structure and considering that the nonwoven filter media taught by the applied prior art is made by a substantially identical wet laid process (lowering the pH and then raising the pH), it appears that the nonwoven filter media inherently possesses the claimed gamma value.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

Regarding claim 14, Pierce discloses that the glass wool fibers of each ply may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14).

Regarding claims 19 and 20, Pierce discloses that the glass wool fibers may be combined with chopped glass fibers forming a filtration layer (see entire document including page 2, lines 23-25).

Regarding claim 20, Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29).

6. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong as applied to claims 13-14 and 19-20 above, and further in view of USPN 4,102,785 to Head.

Pierce does not appear to mention the apparent density of the web, therefore, it would have been obvious to look to the prior art for conventional web densities. Head provides this conventional teaching showing that it is known in the filter art to use a fiber density of about 0.15 to 0.25 g/cc (see column 4, lines 52-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the filter media with a fiber density of 0.15 to 0.25 g/cc, as taught by Head, motivated by the expectation of successfully practicing the invention of Pierce.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong as applied to claims 13-14 and 19-20 above, and further in view of USPN 6,749,753 to Yamaguchi.

Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page 10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer. Pierce does not appear to mention using a larger fiber diameter in one of the supporting plies, but Yamaguchi discloses that it is known in the filtration art to vary the fiber diameter of adjacent plies to increase filtration accuracy and increase filtration life (see entire document including

column 2, lines 29-44). Yamaguchi discloses that the larger fibers may have a diameter of 1.1 to 20 times as large as the smaller diameter (column 6, lines 38-49). Considering that Pierce discloses that the glass wool fibers of each ply may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14), it would have been obvious to use fibers with a diameter of 0.69 microns in one ply and fibers with a diameter of 4.2 microns in at least one of the supporting plies, because the filter would possess increased filtration accuracy and increased filtration life.

8. Claims 1-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong in view of USPN 6,420,024 to Perez.

Pierce discloses a nonwoven filter media comprising a layer of glass wool fibers combined with chopped glass fibers (see entire document including page 2, lines 23-25). Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and that the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29). Pierce discloses that the glass wool fibers may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14). Pierce discloses that the chopped glass fibers may have a diameter in the range of 5.0 to 9.0 microns (page 7, lines 22-24). Pierce discloses that the filter media may be a wet laid filter media (page 14, lines 17-18).

Pierce discloses that a dispersant may be added to the slurry (page 12, line 1 to page 13, 5) and that the resulting slurry may have a pH of about 2.2 to about 3.2 (page 15, lines 7-17). Pierce does not appear to mention raising the pH of the nonwoven glass layer during the wet laid process after the dispersant is added, but Dong discloses that it is known in the wet laid nonwoven glass art to form a glass fiber nonwoven with uniform weight by first contacting the

glass fibers with the combination of a charged viscosity modifier and a dispersant followed by the separate addition of an oppositely charged viscosity modifier, resulting in a slurry with a pH in the range of from about 5 to about 10 (see entire document including column 2, lines 20-43 and column 6, lines 58-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to raise the pH from a low pH value, as taught by Dong, because the nonwoven filter media would advantageously possess a uniform weight.

Regarding the claimed gamma value, considering that the nonwoven filter media taught by the applied prior art is substantially identical to the claimed nonwoven filter media in structure and considering that the nonwoven filter media taught by the applied prior art is made by a substantially identical wet laid process (lowering the pH and then raising the pH), it appears that the nonwoven filter media inherently possesses the claimed gamma value.

Pierce appears to be silent with regards to a specific surface area, therefore, it would have been obvious to look to the prior art for conventional surface areas. Perez provides this conventional teaching showing that it is known in the filtration art to use a surface area of greater than $0.25 \text{ m}^2/\text{gm}$, typically about 0.5 to $30 \text{ m}^2/\text{g}$ (see column 2, lines 8-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the surface area from about 0.5 to $30 \text{ m}^2/\text{g}$, motivated by the expectation of successfully practicing the invention of Pierce.

Regarding claims 2-3, 9-10 and 14, Pierce discloses that the glass wool fibers of each ply may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14).

Regarding claims 4-6 and 19-20, Pierce discloses that the glass wool fibers may be combined with chopped glass fibers forming a filtration layer (see entire document including page 2, lines 23-25).

Regarding claims 6 and 20, Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29).

Regarding claims 7 and 11, Pierce discloses that the filter media may be a wet laid filter media (page 14, lines 17-18).

Regarding claims 8-12 and 16-17, Pierce does not appear to mention the apparent density of the web, but considering that the nonwoven filter media taught by the applied prior art possesses an identical surface area and is made with an identical wet laid process producing a substantially uniform web, it appears that the apparent density of the web is inherently at least about 0.15 g/cc.

Regarding claims 13-17 and 19-20, Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page 10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong in view of USPN 6,420,024 to Perez as applied to claims 1-17 and 19-20 above, and further in view of USPN 6,749,753 to Yamaguchi.

Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page

10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer. Pierce does not appear to mention using a larger fiber diameter in one of the supporting plies, but Yamaguchi discloses that it is known in the filtration art to vary the fiber diameter of adjacent plies to increase filtration accuracy and increase filtration life (see entire document including column 2, lines 29-44). Yamaguchi discloses that the larger fibers may have a diameter of 1.1 to 20 times as large as the smaller diameter (column 6, lines 38-49). Considering that Pierce discloses that the glass wool fibers of each ply may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14), it would have been obvious to use fibers with a diameter of 0.69 microns in one ply and fibers with a diameter of 4.2 microns in at least one of the supporting plies, because the filter would possess increased filtration accuracy and increased filtration life.

10. Claims 8-12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong in view of USPN 6,420,024 to Perez as applied to claims 1-17 and 19-20 above, and further in view of USPN 4,102,785 to Head.

In the event that it is shown that the apparent density of the web is not inherently about 0.15 to 0.21 g/cc, Head discloses that it is known and typical in the filter art to use a fiber density of about 0.15 to 0.25 g/cc (see column 4, lines 52-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the filter media with a fiber density of 0.15 to 0.25 g/cc, as taught by Head, because it is understood by one of ordinary skill in the art that the apparent density effects a property such as filtration efficiency

and because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Response to Arguments

11. Applicant's arguments and declaration filed 3/14/2008 have been fully considered but they are not persuasive.

The applicant asserts that the applied prior art does not teach or suggest the claimed glass nonwoven with a gamma value of at least 14 because the submitted declaration (B) Examples do not possess the claimed gamma value. The examiner respectfully disagrees. The Examples of the declaration have a gamma value very close to 14 (e.g., 13.73). Clearly the teachings of the applied prior art are not limited to the 6 examples disclosed in the declaration. The applied prior art teaches a large number of variables. Considering that the nonwoven taught by the applied prior art is substantially identical to the claimed nonwoven in structure, and considering that the nonwoven filter media taught by the applied prior art is made by a substantially identical wet laid process (lowering the pH and then raising the pH), it appears that the applied prior art teaches at least one nonwoven embodiment possessing the claimed gamma value. Pierce discloses that one skilled in the art desires a low penetration and low pressure drop (page 10, lines 18-24). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the materials and/or the process within the boundaries disclosed by the applied prior art, but beyond those of the declaration (B) Examples, to obtain the claimed gamma value.

Conclusion

12. The following patents are cited to further show the state of the art with respect to an acidic dispersant:

WO 02/16005 to Sato (USPN 6,939,386 cited as translation document)

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/
Primary Examiner, Art Unit 1794